

Remarks

Reconsideration and withdrawal of the rejection set forth in the above-mentioned Office Action are respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-4, 7, and 13 remain pending in the application, with Claim 1 being independent. Claim 13 has been amended for reasons unrelated to patentability to improve its form.

Request for Interview

Applicants respectfully request a personal interview with the Examiner in this case. If the Examiner picks up this case for examination before receiving a telephone call from the undersigned to schedule an interview, Applicants respectfully request that the Examiner telephone the undersigned to schedule the interview.

Rejection

Claims 1-4, 7 and 13 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,233,426 (Lee) in view of U.S. Patent No. 5,541,712 (Fujitaka).

Response to Rejection

This rejection is respectfully traversed for the following reasons.

Independent Claim 1 relates to an original cover of an image reading apparatus, comprising a cover member for covering an original placed on an original stand, and a hinge

member having one end thereof pivotally supported by the cover member and having the other end thereof mounted on and pivotally supported by the original stand. The cover member is biased in a direction in which the cover member is opened with respect to the hinge member and is further biased in a direction parallel to an axis of a rotary shaft of the hinge member by a spring.

MPEP § 2142 places the initial burden on the Office to factually support any *prima facie* conclusion of obviousness. Therefore, to reject Claim 1, the Office must allege facts showing that the claimed cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis would have been obvious to one skilled in the art. And that factual burden must be satisfied without resort to Applicant's own disclosure:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (MPEP § 2142)(emphasis added)

Thus, to reject Claim 1 for obviousness, the Office must rely on facts gleaned from the prior art to render this feature obvious. But the only document that discloses or suggests cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis is

Applicants' own disclosure. The prior art is silent on this crucial fact. The Lee patent, Applicants submit, merely shows a cover member 86, that can pivot around third pivots 82 (column 5, lines 36-38 and lines 62-65), while the Fujitaka patent is understood to merely show a torsion spring 40 loaded between a holder member 36 and a bracket 39 to bias the bracket clockwise, and another spring 44 loaded between sleeves 41 and 42 to press a document laid on a glass platen 33. No cover-member, biasing in a direction parallel to a hinge-member, rotary-shaft axis is understood to be disclosed. Nor is cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis.

Moreover, the Office Action does not even allege that these documents disclose cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis, let alone cover-member spring biasing in a direction parallel to a hinge-member, rotary-shaft axis.

Instead, page 3 of the Office Action cites the Lee patent to show rotation "in a direction parallel to the axis of a rotary shaft". Applicants submit that this passage of the Office Action is not understandable, because elements are rotated *around* an axis, not in the axis direction. It is completely unclear what type of movement the Office Action is alleging. In addition, cover-member rotation is not the same as cover-member biasing, since an element can be biased without being rotated (i.e., a bias force can be applied to an element, but the element does not move because it is held in place by a stronger force; but when that stronger force weakens or is eliminated, the bias force moves the element). Therefore, the Office Action itself, does not allege that the Lee patent discloses or suggest cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis. Moreover, the sections of the Lee patent cited to show this cover member rotation, Fig. 9B, Fig. 3, and column 5, lines 34-39,

are understood to merely show the rotation of a cover *around* a hinge axis. No biasing in a hinge axis direction is understood to be disclosed. For example, Fig. 9B is understood to merely show pivoting of the cover member 86 around a fourth pivot 108 (col. 6, lines 24 and 25), while Fig. 3 is understood to merely show that articulating links 44 are pivotally mounted to the rigid cover member 46 (col. 4, lines 5-8) and that the first pivots 42 are telescoped into the first holes 58 of the articulating links 44 (col. 3, lines 58-60), so that the cover 46 can pivot around the first pivots 42 (col. 4, lines 23-26). In addition, the passage at column 5, lines 34-39 merely discusses the telescoping of third pivots 82 into holes 98 of the articulating links 84 of the cover assembly 80, which permits pivoting of the cover member 86 of the cover assembly 80 around the pivots 82:

Near one of the side projecting portions 94, the starter 96 extends from one of the side walls 90. The third pivots 82 are telescoped into the third holes 98 causing the articulating links 84 pivotally mounted to the recessed regions 32.

Thus, 1) the Office Action does not allege that the Lee patent discloses or suggest cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis, let alone cover-member spring biasing in the hinge axis direction, and 2) the cited portions of the Lee patent are not understood to disclose or suggest cover-member biasing or movement in a direction parallel to a hinge-member, rotary-shaft axis.

Turning to the Fujitaka patent, page 4 of the Office Action cites this patent to show *an unspecified type of spring biasing* “Fujitaka discloses biasing a cover member with respect to a hinge member by a spring (column 10, lines 1-10 of Fujitaka).” The Office Action does not

cite this patent to teach cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis, as recited by Claim 1. Moreover, column 10, lines 1-10 of this patent does not disclose or suggest cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis, as can be seen by examining this passage:

The cover 34 is lifted up by the following procedure. As shown in FIG. 2, when a book or similar thick document P is laid on the glass platen 33, the bracket 39 is rotated counterclockwise about the shaft 38. Before the bracket 38 is rotated, the bracket 39 and holder member 36 extend substantially collinearly with each other and ready to rotate about the boss 37. Hence, the bracket 39 moves about the boss 37 together with the holder member 36 due to the force of the spring 40 and the force holding the lug 46 of the tongue 46 and the hole 48 in engagement.

Thus, the spring 40 is understood to merely generate an opening moment about the bracket 38. And even if the spring 40 generates an urging force in a direction parallel to the bracket 38 (though Applicants submit that there is no disclosure of this in the Fujitaka patent), since the spring 40 is attached to each side of a cover 34 symmetrically as shown in Figure 1, the forces exerted on the cover 34 are cancelled due to the symmetrical arrangement. Thus, this patent is not understood to teach cover-member, spring biasing in a direction parallel to a hinge-member, rotary-shaft axis, as recited by Claim 1.

Page 4 of the Office Action summarizes the obviousness conclusion by stating that “....it would have been obvious.... to specifically bias the cover member with a spring, as taught by Fujitaka, in the two directions in which the cover member can be rotated in the overall apparatus taught by Lee.” But, this conclusion is based on a false assumption. That assumption is that at least one of these patents disclose or suggest cover-member biasing in a

direction parallel to a hinge-member, rotary-shaft axis. But neither the Lee patent, nor the Fujitaka patent is understood to disclose or suggest this feature, as noted above, nor does the Office Action allege that the applied art discloses or suggests such a feature. In addition, as also noted above, the Office Action has not even established movement of a cover in the hinge-axis direction.

Since the crucial fact of cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis is found only in Applicants' own disclosure, Applicants submit that the Office's conclusion of obviousness is based on impermissible hindsight in using Applicants' own disclosure to provide the suggestion to modify the references to produce the invention of Claim 1. Therefore, the Office has not satisfied its burden of proof to establish a *prima facie* case of obviousness against Claim 1.

In addition, MPEP § 2142 requires the cited art to disclose or suggest *all* the claimed features ("the prior art reference (or references when combined) must teach or suggest all the claim limitations."). But since the patents to Lee and Fujitaka are not understood to do so, as noted above, the Office has not satisfied its burden of proof to establish a *prima facie* case of obviousness against Claim 1 for the additional reason.

Further, MPEP § 2142 requires a legally sufficient motivation to combine the references to produce the claimed invention to support a *prima facie* case of obviousness:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been

obvious in light of the teachings of the references". Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09

But here, as noted above, the references do not expressly or impliedly suggest the claimed cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis, as recited by Claim 1. As a result, to establish a motivation to combine, the Office must provide a convincing line of reasoning supported by knowledge generally available to those skilled in the art, scientific principles, or legal precedent, as required by MPEP § 2144. But, the Office Action's reasoning is unconvincing because it is based on a false assumption and unsupported by knowledge generally available to those skilled in the art, scientific principles, or legal precedent, as required by MPEP § 2144. This can be seen as follows. Page 4 of the Office Action states that it would obvious to "... specifically bias the cover member with a spring, as taught by Fujitaka, in the two direction in which the cover member can be rotated in the overall apparatus taught by Lee.". But as noted above, it is not clear what is meant by rotation in a hinge axis direction, and the Office Action has provided no evidence that the Lee patent teaches movement or biasing of a cover member in a direction parallel to a hinge-member, rotary-shaft axis. Therefore, this argument is based on a false assumption about what is shown in the Lee patent. In addition, the Office Action fails to establish that knowledge generally available to the skilled artisan or established scientific principles teach the claimed cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis. Further, the Office Action cites no legal precedent from which to argue that obviousness of adding the claimed cover-member biasing in a direction parallel to a hinge-member, rotary-shaft axis to

the references. Thus, under MPEP § 2142 and § 2144, the Office has not established a legally sufficient motivation to combine the art to produce the invention of Claim 1.

For all of these reasons, Applicants respectfully request that the rejection of Claim 1 be withdrawn.

The other rejected claims in this application depend from one or another of the independent claim discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

Conclusion

This Amendment After Final Rejection does not raise new issues, is an earnest attempt to advance prosecution and reduce the number of issues, and is believed to clearly place this application in condition for allowance. This Amendment was not earlier presented because Applicants earnestly believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of this Amendment under 37 CFR 1.116 is respectfully requested.

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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